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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,032	09/20/2001	Alan J. Lang	D-2821CON	6533

7590 04/18/2003

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EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 04/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/960,032

Applicant(s)

LANG, ALAN J.

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)


- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The amendment filed 2/4/03 has been entered as Paper No. 6. Claims 26-45 have been canceled, and new claims 46-64 have been added.

Specification


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2. Claims 46 and 57 require that the IOL comprise a single, unitary multifocal lens body, and claims 51 and 61 require that the lens body includes no cylinder correction. The specification is objected to because, while these limitations are supported in the Figures, they must now be included into the written specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49, 50 and 57-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claims 49, 50 and 57-60 each recite a "substantially identical intraocular lens". It is unclear how similar the IOL must be in order for it to constitute it as being substantially identical. Neither the specification nor the claims define the metes and bounds of this limitation, thereby rendering the claims indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 46, 48-50 and 57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Menezes et al. (USPN 5,847,802 as cited in applicant's IDS).

Menezes et al. discloses a single, unitary multifocal intraocular lens (column 1, lines 22-25 and Figure 1) for use in an eye having a natural lens (column 4, lines 52-53, wherein the statement that "*Some patients may not require the full...add power in these designs.*" clearly suggests use with the natural lens of the eye with natural lens having natural accommodative capability, otherwise full add power correction would be necessary for full near vision). The lens has a baseline optical power (12) and a plurality of annular regions each having an optical add power (column 5, table). Menezes et al. discloses at column 4, lines 64-65 that the near add power could be a non-constant function across the concentric annular rings, which means that there is an annular ring with a first maximum optical add power for near vision and a second optical add power intermediate between the first maximum optical add power and the baseline optical add power. Menezes et al further discloses that when full add power is not required, the near power can be made a fraction (preferably 50%) of the full add power (column 4, lines 52-55). Thus, since the first optical add power for near vision of the IOL is made to be a fraction of the full near add power, the combination of the first optical add power for near vision and the

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natural accommodative capability of the natural lens of the eye will provide enhanced vision (claims 46 and 57).

Claim 48, see column 3, lines 3-6 and 13-14 for IOL having one annular region for near optical power and one annular region for distance optical power. Each of these annular regions would have a different optical add power.

Claims 49, 50 and 57-60, see column 4, lines 52-57 for the optical add powers being reduced by at least a certain percentage.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 47, 52-56 and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes et al. in view of Portney (USPN 6,197,058 as cited in applicant's IDS).

Menezes et al. discloses an intraocular with all the elements of claims 46 and 57, but is silent to the additional limitation of a fixation member coupled to the lens body, as required by claim 47. Portney teaches an IOL with a fixation member in order to attach the IOL to the eye, as shown in Figure 3. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Portney to modify the IOL of Menezes et al. to include a fixation member in order to attach the IOL to the eye. Menezes et al. is also silent to the limitations of the lens and fixation member being adapted to be placed in the anterior and

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posterior chambers of the eye, as required by claims 52-55 and 62-63. Portney teaches placing the lens and fixation members in these chambers in order for the lens to function as an IOL. See column 3, lines 61-64. It would have been obvious to one of ordinary skill in the art to place the lens and fixation member the anterior and posterior chambers of the eye if the lens of Menezes et al. is to be used as an intraocular lens, as opposed to a contact lens, for example. Portney also teaches the additional limitations required by claims 56 and 64 of the lens being deformable in order to minimize the size of the incision. See column 3, lines 1-4. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Portney to modify the IOL of Menezes et al. to make the lens deformable in to minimize the size of the incision.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 46-64 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-58, 63-68, 70-75 and 77-78 of copending Application No. 09/302,977. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because these copending applications each claim an intraocular lens having a lens body having a maximum optical add power less than the optical add power required for full near vision correction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. Applicant's arguments filed 2/4/03 have been fully considered but they are not persuasive with respect to Menezes et al. Applicant argues that Menezes et al. does not even suggest the presence of two different add powers in any of the lenses disclosed. Examiner disagrees. As stated in the above rejection, Menezes et al. discloses in column 4, lines 64-65 that the near add optical power could be a non-constant function across the concentric annular rings. This means that the near add optical powers of the annular rings would be different from each other. Inherently, there would be a first add optical power and a second optical power intermediate between the first optical add power and the baseline optical power.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

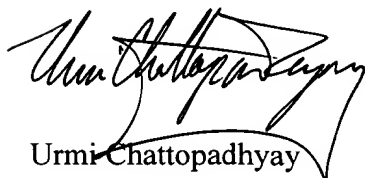
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

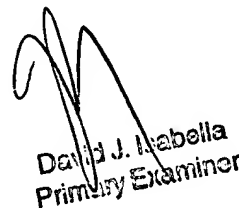
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 305-3590. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

Art Unit 3738



David J. Abella
Primary Examiner

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April 16, 2003